APPENDIX

Final Hearing
February 26, 1975

Paper No. 118
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Apr. 11, 1975

BOARD OF PATENT INTERFERENCES

IN THE UNITED STATES
PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT INTERFERENCES

Patent Interference No. 97,787

MEITZNER et al. v. MINDICK et al.

Production of Ion Exchange Resin Particles

Application of Erich Meitzner and James A. Oline filed July 18, 1958, Serial No. 749,526.

Patent granted Morris Mindick and Jerry J. Svarz, December 22, 1970, Patent No. 3,549,562 on Serial No. 463,923 filed June 14, 1965. Accorded benefit of Ser. No. 691,541 filed October 22, 1957.

Messrs. Christen and Sabol; Bergin, Quinn, Meyers, Simmons, Doherty and Neruda for Meitzner et al. Oral argument by Eugene Sabol.

Messrs. Johnston, Root, O'Keeffe, Keil, Thompson and Shurtleff; Griswold, Burdick, and Whale for Mindick et al. Oral argument by Herbert B. Keil.

Modance, McKelvey and Calvert, Examiners of Interferences

McKelvey, Examiner of Interferences

This interference involves (1) an application [1] of Erich Meitzner and James A. Oline (Meitzner), the junior party and assignors to Rohm and Haas Company, and (2) a patent [2] issued to Morris Mindick and Jerry J. Svarz (Mindick), the senior party and assignors to Dow Chemical Company.

Both parties filed briefs and appeared, through counsel, at final hearing.

The Counts

The inventions defined by the ten counts of this interference relate to:

(1) a method of making "raw beads" which can be converted to ion exchange resins (count 1 through 6);

(2) a method of making ion exchange resins from raw beads (counts 7 and 8);

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[1] Application, Serial No. 749,526, filed July 18, 1958.

[2] U.S. patent 3,549,562, issued December 22, 1970, based on application, Serial No. 463,923, filed June 14, 1965, as a continuation of application, Serial No. 691,541, filed October 22, 1957 (now abandoned).

(3) raw beads capable of being formed into ion exchange resins (count 9); and

(4) ion exchange resins made from raw beads (count 10).

Counts 1 and 5 are representative and read:

Count 1

A process for producing copolymers of increased porosity which comprises:

(A) dissolving from 50 to 88% by weight of a monovinyl aromatic monomer and from 12 to 50% of a polyvinyl aromatic monomer in an inert organic liquid which is a solvent for the monomers but is a nonsolvent for the polymerized product of the monovinyl and polyvinyl monomers, said solvent being present in an amount of about 30 to 70% by weight based on the weight of solution;

(B) incorporating said solution into an excess of water to form a dispersion of droplets; and

(C) copolymerizing said monovinyl and said polyvinyl monomers while suspended in said aqueous medium and and in the presence of said inert organic liquid.

Count 5

A process for producing solid vinylaromatic copolymer beads suitable for preparation of ion-exchange resin beads characterized by increased purosity and reduced swelling and shrinkage in use which comprises:

(A) dissolving a monovinyl aromatic monomer and a polyvinyl aromatic monomer in an inert organic liquid which is a solvent for the monomers but is a nonsolvent for the polymerized product of the monovinyl and polyvinyl monomers, said solvent being present in an amount of about 30 to 70% by weight based on the weight of solution;

(B) suspending the monomer solution as dispersed droplets in an aqueous dispersion medium; and

(C) copolymerizing said monomers in aqueous dispersion to form solid copolymer beads which upon chloromethylation to give an average of from 0.75 to 1.5 chloromethyl groups per aromatic nucleus and subsequent amination with trimethylamine yield trimethyl quaternary ammonium anion-exchange resins characterized in chloride form by:

(1) a water holding capacity of from 40 to 65 weight percent; and

(2) a volume expansion on conversion into hydroxide form of less than 30 percent.

Unresolved Matters Deferred to Final Hearing

1. *Motion by Meitzner for Leave to Amend Preliminary Statement*

On March 15, 1973, Meitzner filed a motion (Paper No. 34) for leave to amend his preliminary statements. Citing *Forsberg* v. *Bradbury*, 1912 C.D. 89 (Comm'r. Pat. 1912), the Patent Interference Examiner deferred a ruling on the motion to final hearing (Paper No. 37).

A ruling on the motion requires background knowledge on the nature of the invention defined by the counts. With reference to count 1, the invention relates to a method of making raw beads in which a monovinyl aromatic monomer and a polyvinyl aromatic monomer are dissolved "in an inert organic liquid which is a solvent for the monomers but is a nonsolvent for the . . ." raw beads. The solvent as defined in the counts, is broad enough to read on the use of both "swelling" solvents, such as toluene, and "non-swelling" solvents, such as tertiary amyl alcohol.

Meitzner took testimony with the apparent intention of proving conception and actual reduction to practice of the invention defined by the counts on the basis of work with both swelling and non-swelling solvents. Reference to the mentioned testimony appears in Meitzner's briefs. At the oral hearing of this case, however, counsel for Meitzner represented to this Board that Meitzner no longer would rely on priority proofs related to the use of swelling solvents. Instead Meitzner now intends to rely solely on priority proofs related to the use of non-swelling agents, specifically work involving the use of tertiary amyl alcohol which took place in 1957.

In his motion, Meitzner seeks to amend his preliminary statement to allege events which occurred prior to 1957. In view of counsel's representation at the oral hearing to the effect that only work which occurred in 1957 would be relied upon, Meitzner's motion for leave to amend his preliminary statement has become moot. Accordingly, the motion is *dismissed* as moot.

2. Motions by Meitzner for Leave to Add Documents Upon Which He Intends to Rely

On September 24, 1973, Meitzner filed a "third" motion for leave to add documents upon which he intends to rely (Paper No. 56). The Patent Interference Examiner deferred a ruling on this motion to final hearing (Paper No. 57).

On October 29, 1973, Meitzner filed a "fourth" motion for leave to add documents upon which he intends to rely (Paper No. 61). On February 1, 1974, the Board entered an order deferring a ruling on the motion to final hearing (Paper No. 72).

According to the "third" motion;

> ". . . on August 17, 1973, it was learned . . . that certain of the . . . raw beads . . . prepared . . . in

> 1955 and 1956 would have the characteristics outlined near the end of counts 5 through 10, if such . . . [raw beads] were chloromethylated and aminated in the manner designated in said counts."

Inasmuch as Meitzner no longer relies on work performed in 1955 and 1956, Meitzner's "third" motion for leave to add documents upon which he intends to rely is *dismissed* as moot.

According to the "fourth" motion:

> "During . . . testimony on September 18, 1973, . . . Barrett described his characterizing tests that had been performed [in October, 1973] . . . on raw beads and ion exchange resins reproduced in accordance with 1955 work . . . utilizing Butarez as an organic liquid in the copolymerization of styrene and divinylbenzene. The characterization work was necessary . . . to establish the properties of the raw bead and resulting ion exchange resin as specified in . . . counts 5 through 10."

Again, since Meitzner no longer relies on work performed in 1955, Meitzner's "fourth" motion for leave to add documents upon which he intends to rely is *dismissed* as moot.

Mindick Motion for Judgment on the Record

On October 10, 1973, Mindick filed a motion to dissolve and/or for judgment on the record (Paper No. 59). On February 1, 1974, the Board entered an order denying the motion, noting:

"[a]ny argument as to what the record shows may be presented in the briefs at final hearing" (Paper No. 72). The parties have briefed and argued Mindick's motion for judgment on the record at final hearing.

Meitzner lost an interference (No. 92,816) in which the sole count was directed to a method of making raw

beads having a sponge-like porosity. One step of the method defined by that count [3] called for dissolving styrene and divinyl benzene in an "inert organic liquid . . . selected from the group consisting of an inert aliphatic oxygen-containing solvent and an inert aliphatic hydrocarbon solvent . . . ." [4] *Meitzner* v. *Corte*, 56 CCPA 1099, 410 F.2d 433, 161 USPQ 599 (1969).

According to Mindick, it is questionable whether Meitzner's application describes a process in which swelling solvents, such as toluene, may be used to make raw beads. During the testimony period, Mindick believes he was able to obtain an admission from Dr. Harold E. Weaver, an employee of Rohm and Haas Company, to the effect that at the time the Meitzner application was prepared Rohm and Haas Company deliberately intended to *exclude* any description concerning the use of toluene from the Meitzner application. Based on this admission, Mindick alleges that:

(1) Meitzner has no "standing" in this interference to contest priority of a generic invention directed to the use of both swelling and non-swelling solvents, because (i) he lost an interference on the use of non-swelling solvents and (ii) he "abandoned" the invention with respect to the use of swelling solvents, and

(2) a generic claim directed to the use of both swelling and non-swelling solvents is not patentable to Meitzner, because Meitzner discloses only the use of non-swelling solvents [35 U.S.C. § 112, first paragraph].

We hold that Mindick is not entitled to prevail on the issue of priority on the basis of his motion for judgment on the record.

The breadth of a count determines the extent of the available priority proofs with respect to that count. Thus,

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[3] The count is reproduced at 161 USPQ 600, column 2.

[4] According to Mindick, these solvents are non-swelling solvents.

the mere fact Meitzner was unable to prove priority of a non-swelling subgenus on the basis of tertiary amyl alcohol *vis-a-vis* Corte does not prevent Meitzner from attempting to prove priority of a swelling/non-swelling genus on the basis of tertiary amyl alcohol *vis-a-vis* Mindick. Stated in other terms, the fact that Corte is the first inventor of the non-swelling subgenus in no way proves Mindick is the first inventor of the swelling/non-swelling genus *vis-a-vis* Meitzner.

Mindick's allegations based on undue breadth and "abandonment" due to Meitzner's alleged failure to disclose the use of swelling solvents are arguments to the effect that Meitzner's specification is not broad enough to support claims drawn to use of both swelling and non-swelling solvents. The question of undue breadth is not ancillary to priority. *Fried* v. *Murray*, 46 CCPA 914, 268 F.2d 223, 122 USPQ 361 (1959); *Den Beste* v. *Martin*, 45 CCPA 798, 252 F.2d 302, 1116 USPQ 584 (1958). Moreover, with respect to "abandonment," we note that Meitzner no longer seeks to prove priority on the basis of swelling solvents and Mindick does not allege that Meitzner "abandoned" any invention based on the use of non-swelling solvents.

Mindick Motion to Dissolve Based on 35 U.S.C. 135(b)

After the decision on motions in this interference, Mindick moved to dissolve with respect to counts 5 through 10 (Paper No. 33). According to Mindick, Meitzner did not make claims 51 through 56, which correspond to counts 5 to 10, within the one year period of section 135(b). On March 29, 1973, the Patent Interference Examiner dismissed the motion, because it was "belated" and was "not accompanied by a verified showing of facts to excuse" the belatedness (Paper No. 37).

37 C.F.R. 1.258(a) provides:

> "A party shall not be entitled to raise [an issue of] nonpatentability unless he has duly presented a motion for dissolution under § 1.231 upon such ground or shows good reason . . . why such a motion was not presented; however, to prevent *manifest* injustice the Board . . . may in its discretion consider a matter of this character even though it was not raised by motion . . . ."

Mindick has not shown good cause for his not having presented the motion timely. Nor do we find any manifest injustice since it is not clear to us that Meitzner was not claiming substantially the same invention as defined by Mindick's patent claims within one year from the date the Mindick patent issued. Accordingly, Mindick's motion to dissolve based on section 135(b) provides no basis for awarding priority to Mindick.

Mindick Motion to Dissolve on the Ground of Junior Party Estoppel

I. *Finding of Fact with Respect to the Estoppel Issue*

1. On May 15, 1962, Interference No. 92,815 was declared involving four parties:

(i) Millar,

(ii) Meitzner, on the basis of the application involved in the present interference.

(iii) Corte, and

(iv) Mindick, on the basis of the parent of the application which matured into the involved Mindick patent.

2. When Interference No. 92,815 was declared, Mindick was the senior party.

3. The sole count in Interference No. 92,815 reads:

"A process for producing ion exchange resin particles of increased porosity which process comprises:

A. Dissolving a major amount of styrene and a minor amount of divinyl benzene in an inert hydrocarbon solvent, said solvent being present in an amount of about 50 percent by weight based on the weight of solution;

B. Incorporating said solution into an excess of water to form a dispersion of droplets;

C. Popolymerizing said styrene and said divinyl benzene while suspended in said aqueous medium and in the presence of said inert hydrocarbon;

D. Chloromethylating the formed copolymer;

E. Reacting the chloromethylated copolymer with a tertiary amine to form said ion exchange resin particles."

4. During the motion period, Mindick moved to substitute Proposed Count A (92,815, Paper No. 11). Proposed Count A reads:

"A process for producing ion exchange resin particles of increased porosity which process comprises:

A. Dissolving a major amount of styrene and a minor amount of benzene in an inert organic compound which is a solvent for the monomers but is a nonsolvent for the polymerized product of styrene and divinyl benzene, said solvent being present in an amount of about 50 percent by weight based on the weight of solution;

B. Incorporating said solution into an excess of water to form a dispersion of droplets; and

C. Copolymerizing said styrene and said divinyl benzene while suspended in said aqueous medium and in the presence of said inert organic compound."

Meitzner opposed Mindick's motion, *inter alia*, on the ground that Proposed Count A was unpatentable over the prior art (92,815, Paper No. 28, p.12).

5. Meitzner moved to dissolve the interference (92,815, Paper No. 16), *inter alia*, on the ground the count was unpatentable over the prior art. Meitzner also moved to substitute a Proposed Count 1, contingent on the denial of his motion to dissolve (92,815, Paper No. 12). Mindick opposed Meitzner's motion to dissolve (92,815, Paper No. 27 p. 10).

6. Corte moved for the benefit of a German application and to shift the burden of proof contingent on the interference not being dissolved. (92,815, Paper No. 13).

7. On November 22, 1963 a judgment was entered against Millar (92,815, Paper No. 21).

8. On February 14, 1964, the Primary Examiner entered his decision on motions (92,815, Paper No. 29). Meitzner's motion to dissolve based on unpatentability of the count was *granted*. The granting of this motion rendered *moot* Meitzner's contingent motion to substitute Proposed Count 1. Mindick's motion to substitute Proposed Count A was *denied*, because the Primary Examiner held the proposed count unpatentable. Corte's motion for benefit and to shift the burden of proof was *granted*.

9. Mindick requested reconsideration (92,815, Paper No. 35) arguing the count was patentable over the prior art. Meitzner opposed (92,815, Paper No. 36) and continued to argue the count was unpatentable over the prior art. On reconsideration, the Primary Examiner adhered to his views that the count was unpatentable (92,815, Paper No. 38). The Primary Examiner also refused to vacate his decision granting Corte's motion for benefit and to shift the burden of proof and Interference No. 92,815 was dissolved.

10. After the dissolution of Interference No. 92,815, Mindick abandoned his application and filed a continuation thereof—the continuation is the application which matured into the involved Mindick patent.

11. Claim 1 of the Mindick continuation, as filed, reads:

> "A process for producing ion exchange resin particles of increased porosity which comprises:
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> A. Dissolving from 50 to 88% by weight of a monovinyl aromatic monomer and from 12 to 50% of a polyvinyl aromatic monomer in an inert organic compound which is a solvent for the monomers but is a nonsolvent for the polymerized produce of the monovinyl and polyvinyl monomers, said solvent being present in an amount of about 30 to 70% by weight based on the weight of solution;
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> B. Incorporating said solution into an excess of water to form a dispersion of droplets; and
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> C. Copolymerizing said monovinyl and said polyvinyl monomers while suspended in said aqueous medium and in the presence of said inert organic compound."

12. During the prosecution, the Primary Examiner rejected four claims, including claim 1, *supra*, and allowed six other claims. In due course, Mindick appealed to the Board of Appeals, where a decision was entered on December 28, 1966, reversing the Primary Examiner's rejection of the above mentioned four claims.

13. On March 29, 1968, a second interference, No. 96,314, was declared involving:

> (i) Meitzner, on the basis of the application involved in the present interference,
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> (ii) Corte, and

(iii) Mindick, on the basis of the application which matured into the involved Mindick patent.

14. When Interference 96,314 was declared, Mindick was the senior party.

15. The sole phantom count in Interference 96,314 reads:

> "A process for the production of a copolymer of an aromatic vinyl monomer and an aromatic polyvinyl monomer which comprises
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> (1) dissolving from about 50-96% by weight of a monovinyl aromatic monomer and from about 0.5 to 50% by weight of a polyvinyl aromatic monomer in a inert organic liquid which is a solvent for the monomers but is a non-solvent for the polymerized product of the monovinyl and polyvinyl monomers said solvent being present in an amount of 20-300% by weight based on the weight of monomers;
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> (2) incorporating the resulting solution into an excess of water to form a dispersion of droplets; and
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> (3) copolymerizing said monovinyl and said polyvinyl monomers while suspended in said aqueous medium in the presence of said inert organic liquid, the weight percent of monovinyl and polyvinyl monomers being based on the total weight of said monomers."

16. During the motion period, Meitzner filed a motion to dissolve the interference, *inter alia*, on the ground the count was unpatentable over the prior art (96,314, Paper No. 16). Meitzner also moved to substitute Proposed Counts A or B, contingent on the *denial* of his motion to dissolve.

17. Corte moved, *inter alia*, for the benefit of a German application and to shift the burden of proof, con-

tingent on the Primary Examiner denying motions to dissolve (96,314, Paper No. 15).

18. On January 16, 1969, the Primary Examiner entered his decision on motions (96,314, Paper No. 27). Meitzner's motion to dissolve based on unpatentability of the count was *denied*. Likewise, Meitzner's motion to substitute either Proposed Counts A or B was *denied*. Corte's motion for benefit and to shift the burden of proof was *granted*, making *Corte* the senior party.

19. Meitzner, being dissatisfied with the decision on motions, filed a petition to the Commissioner (96,314, Paper No. 31) in which he again urged that the count was unpatentable and that either Proposed Counts A or B should be substituted.

20. Rather than deciding the merits of Meitzner's petition, the Commissioner, acting through the First Assistant Commissioner, ordered the parties to show cause why Interference No. 96,314 should not be dissolved (96,314, Paper No. 33). In the opinion in support of the order to show cause, the Commissioner stated:

"The count of the present interference, if proper now, would have been equally proper [during Interference No. 92,815] as a substitute count, but it was not proposed by the Examiner or by any party."

21. Corte responded to the order to show cause by agreeing the interference should be dissolved (96,314, Paper No. 34).

22. Meitzner responded to the order to show cause and maintained the interference should not be dissolved, but should continue only on the basis of Proposed Counts A or B (96,314, Paper No. 36). Meitzner's response constituted a shift in his position. During the motion period Meitzner sought to dissolve on the ground the count was unpatentable and made a motion, contingent on the denial of the

motion to dissolve, to substitute Proposed Counts A or B. Before the Commissioner, on the other hand Meitzner sought to substitute Proposed Counts A or B even if the interference was dissolved as to the count then involved.

23. Mindick responded to the order to show cause and maintained the interference should not be dissolved (96,-314, Paper No. 35).

24. On April 10, 1969, the Commissioner entered a decision dissolving Interference No. 96,314 (96,314, Paper No. 41). Requests for reconsideration were filed by Mindick (96,314, Paper No. 43) and Meitzner (96,314, Paper No. 42). On June 6, 1969, the Commissioner denied the requests for reconsideration (96,314, Paper No. 44),

25. On July 29, 1969, the Primary Examiner entered an Office action in the Mindick continuation in which he (1) withdrew the allowance of four claims, including claim 1, and (2) rejected the four claims on the basis of "estoppel." The rejection was based on the Commissioner's decisions (Finding 23, *supra*) and the fact that Mindick was a "junior" party in Interference No. 96,314 in view of the granting of the Corte motion to shift the burden of proof. The estoppel rejection was made final on November 24, 1969.

26. Following the final rejection, Mindick filed a petition to the Commissioner pursuant to 37 C.F.R. 1,181 seeking review of the estoppel rejection. A notice of appeal was also filed.

27. On March 3, 1970, the Commissioner, acting through the Director of Group 140, entered a decision holding the action of the Primary Examiner rejecting four claims in the Mindick continuation to have been improper. The Director held that the decision on motions in Interference No. 96,314 granting Corte's motion to shift was in effect *vacated* by the action of the First Assistant Commissioner, citing *Furukawa* v. *Garty*, 151 USPQ 110 (Comm'r Pat. 1965).

28. After the Director's decision, Mindick presented additional claims, which the Primary Examiner entered, and the Mindick continuation was passed to issue. The Mindick patent issued on December 22, 1970.

29. After the Mindick patent issued, Meitzner presented claims 47 through 50 for the purpose of an interference with the Mindick patent.

30. This interference was declared on October 21, 1971.

31. As declared, four counts were involved, count 1 being reproduced above under the heading "*The Counts.*" Counts 5 through 10 were added to this interference on motion of Meitzner.

32. During the motion period of this interference, Mindick moved to dissolve on the ground that claims corresponding to the counts are not patentable to Meitzner, because of "junior party estoppel" (Paper No. 13). The Primary Examiner could not find a "clear basis" for junior party estoppel. Accordingly, by analogy to the practice in connection with motions to dissolve on the ground of no right to make, the Primary Examiner denied Mindick's motion (Paper No. 25). The noted practice provides:

> "In order to preserve the *inter partes* forum for consideration of this matter [right to make] a motion to dissolve on this ground [no right to make] should not be granted where the decision is a close one but only where there is clear basis for it." [5]

II. *Opinion Relating to the Estoppel Issue*

Estoppel, personal to the parties in an interference, "relates to matters which have been determined to be ancillary to priority," within the meaning of 37 C.F.R.

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[5] See M.P.E.P. 1105.02, page 183, col. 1, last sentence of the first full paragraph (3rd Ed., Rev. 42, October, 1974).

1.258(a). *Cf. Plumat* v. *Dunipace*, 464 F.2d 1403, 175 USPQ 105 (CCPA 1972); *Avery* v. *Chase*, 26 CCPA 823, 101 F.2d 205, 40 USPQ 343 (1939). Accordingly, th matter of whether Meitzner is estopped to contest priorit *vis-a-vis* Mindick is properly before us at final hearing.

The doctrine of estoppel is based on the established principle that an interference settles not only the rights of the parties under the counts of the interference, but also settles every question which might have been presented and determined. Estoppel is not applicable to a party enjoying the status of a senior party in the interference. 37 C.F.R. 1.257(b); *Plumat* v. *Dunipace, supra.*

Whether estoppel applies in a given case manifestly depends on the particular facts of the case. Prior decisions, based on different facts, therefore are of little assistance in reaching a decision on the estoppel issue in this interference.

Based on the Findings of Fact listed above, we hold that Meitzner is estopped *vis-a-vis* Mindick to contest priority in this interference. Meitzner failed, in Interference No. 92,815, to seek to contest priority *vis-a-vis* Mindick (with or without Corte) with respect to the present counts.

The dissolution of Interference No. 92,815 settled not only the rights of Mindick and Meitzner with respect to the count there involved, but also the parties' rights with respect to any count which might have been the basis for a priority contest between Mindick and Meitzner. Meitzner made no effort to move positively to contest priority of any proposed count in Interference No. 92,815, because his contingent motion to substitute was predicated on the Primary Examiner denying Meitzner's motion to dissolve. When the Primary Examiner granted Meitzner's motion to dissolve, Meitzner received all the relief in Interference No. 92,815 which he requested.

When one considers the fact Mindick might lose some or all of his patent claims if Meitzner is now permitted to contest priority and that Mindick's patent might not have issued in the first instance had Meitzner made an attempt in Interference No. 92,815 to contest priority *vis-a-vis* Mindick with respect to the counts involved in this intereference, it is manifest that Mindick is prejudiced by Meitzner's failure to act in Interference No. 92,815. We do not believe Meitzner's failure to act should, at this late date, result in prejudice to Mindick.

We recognize that a second interference was declared by the Patent Office involving, *inter alia* Meitzner and Mindick. However, the ultimate conclusion of the Patent Office, acting through the First Assistant Commissioner, was that the second interference should not have been declared. The ultimate conclusion was based squarely on an estoppel theory.

One reading the various decisions of the First Assistant Commissioner might well reach a conclusion that the estoppel was to run against both Meitzner and Mindick. However, such a conclusion would be plainly at odds with the provisions of 37 C.F.R. 1.257(b), which provide, in effect, that estoppel does not apply to a party enjoying the status of a senior party in an interference which is dissolved as a result of a motion under 37 C.F.R. 1.231. We note that, consistent with the provisions of 37 C.F.R. 1.257(b), the Director held the Primary Examiner's action rejecting Mindick's claims 1 through 4 on the ground of junior party estoppel to have been improper.

III. *Discussion of Meitzner Arguments with Respect to Estoppel*

Meitzner claims that Mindick has waived any right to rely on estoppel, because Mindick failed "to present a timely motion to dissolve based upon . . . estoppel" (reply

brief, p. 17). The plain fact is that Mindick filed a timely motion to dissolve this interference on the basis of junior party estoppel. Mindick's timely motion in this interference, of course, distinguishes this case from *Vickery* v. *Barnhart*, 28 CCPA 979, 118 F.2d 578, 49 USPQ 106 (1941), where Vickery failed to make a timely motion, 49 USPQ at 112, col. 1. Moreover, the meer fact that Mindick urged the First Assistant Commissioner not to dissolve the second interference in which the Mindick continuation application was involved does not mean that Mindick waived a right to protect, in this interference, his involved patent which, of course, issued after dissolution of the second interference.

We deem it manifest that Mindick, as the senior party, was not under any obligation in Interference No. 92,815 to formulate counts, such as those here involved.[6] Moreover, the fact that Mindick chose to have his patent issue with claims which are narrower than the count of Interference No. 92,815 does not alter the estoppel against Meitzner. Mindick had a right to rely on the provisions of 37 C.F.R. 1.257(b) upon Meitzner's failure to act in Interference No. 92,815. Compare *Ex parte Miller*, 124 USPQ 419, 423 (Bd. App. 1959).

Meitzner also claims that Mindick cannot urge estoppel against Meitzner, because Mindick was made a junior party in Interference No. 92,815. We disagree. When Interference No. 92,815 was declared, Mindick was the senior party. It is true that the Primary Examiner granted Corte's motion to shift the burden of proof, thus, apparently making Mindick a junior party *vis-a-vis* Corte. However, the decision of the Primary Examiner granting

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[6] Meitzner's behavior in Interference No. 92,815 should be contrasted to Mindick's behavior in the same interference. It will be noted that Mindick made an attempt, albeit unsuccessful, to have Proposed Count A substituted for the count, whereas Meitzner wanted the interference dissolved.

Corte's motion was clearly erroneous inasmuch as at the same time the Primary Examiner dissolved the interference. See *Furukawa* v. *Garty*, supra.

Moreover, even if we accept Meitzner's contention that Mindick was a junior party to Corte Meitzner overlooks the important fact that only Mindick and Meitzner are involved in this interference. Mindick has always been senior to Meitzner apart from whether Mindick was senior or junior to Corte. Accordingly, Mindick may properly urge estoppel against Meitzner.[7] Any estoppel which Corte might have been able to urge against Mindick in some other interference is of no avail to Meitzner in this interference, since any such right is personal to Corte only.

Lastly, Meitzner maintains that estoppel does not lie against him, because he "has been continuously claiming subject matter covered by the count of" Interference No. 92,815 (reply brief, p. 18 *et seq.*). Merely claiming subject matter in an application will not prevent the type of estoppel here involved; rather it is the failure to move to make that claimed subject matter the subject of a priority contest which creates the estoppel.

IV. *Decision Based on Estoppel*

In view of what we have indicated above, Meitzner is estopped to contest priority of the subject matter here involved *vis-a-vis* Mindick. Accordingly, we award priority to Mindick based on estoppel.

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[7] In this respect, the *Manual of Patent Examining Procedure*, 1110.02 (3rd Ed., Rev. 42, October, 1974) provides: "Where it is only the junior parties to the interference that have common subject matter additional to the subject matter of the interference, the senior one of this subgroup is free to claim this common subject matter."

Priority Proofs

Our decision on the estoppel issue disposes of the interference. However, to complete the record and provide any reviewing court (35 U.S.C. 141-146) with a complete picture, we believe it appropriate to consider the priority proofs.

1. *Mindick's Effective Filing Date*

At the time this interference was declared, Mindick was accorded the benefit of parent application, Serial No. 691,541, filed October 22, 1957 (Paper No. 1), which made him senior party. During the motion period, Meitzner moved to add six counts and the motion was granted. Mindick, however, did not move, as he might have, for the benefit of his parent application with respect to the six counts.

Meitzner claims that Mindick should be made junior party on the basis of the filing date of the application which matured into the Mindick patent, which filing date is subsequent to Meitzner's filing date. We disagree. "[T]he order of taking testimony should be placed upon the applicant last to file [Mindick, in this case] unless all the counts of the interference read upon an earlier application [Mindick's parent application, in this case] which antedates that of the other party." *In re Redeclaration of Interferences*, 1926 C.D. 75, 76 (Comm'r. Pat. 1926). Accordingly, if Mindick was not entitled to the benefit of his parent application with respect to *all* counts, he should have been made the junior party.

However, when the Patent Interference Examiner set the testimony period, he plainly indicated that Meitzner, as junior party, was to proceed first (Paper No. 37). If Meitzner believed that Mindick was not entitled to the benefit of his parent application, the time for Meitzner to speak up was after the testimony period was set. In

view of Meitzner's failure to object to the order in which the Patent Interference Examiner required testimony to be taken, Meitzner will not be allowed, at this time, to argue Mindick should be junior party.

2. *Mindick's Preliminary Statement*

The named inventors in the Mindick patent are Mindick and Svarz. The preliminary statement filed by Mindick in this interference is signed only by Mindick. Accompanying the preliminary statement was a paper, signed by counsel, indicating that "[o]n investigation, it has been found that Morris Mindick was the sole inventor of the subject matter set forth in the Counts of the Interference."

A preliminary statement must ordinarily be signed by the *inventor*. 37 C.F.R. 1.215(a). Accordingly, we will review Mindick's priority proofs to determine whether Mindick, as a sole inventor, conceived and actually reduced to practice prior to his effective filing date of October 22, 1957. If we do not find that Mindick conceived [8] and actually reduced to practice prior to October 22, 1957, the party Mindick and Svarz will be restricted to their effective filing date.

3. *Mindick's Priority Proofs*

Mindick alleges that he conceived in invention on April 6, 1955, and in support of his allegation refers to a "Research Suggestion" (Mindick Ex. 8) in which the following appears:

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[8] Mindick has not argued conception coupled with diligence. Hence, no diligence issue is presented.

"(a) Suspension polymerization of styrene-DVB [9] (>8%) mixture to which has been added, before or during polymerization, a limited amount of an organic swelling agent."

We do not regard Mindick's "Research Suggestion" as a conception of the invention defined by the counts. The "Research Suggestion" constitutes, at the very best, a general idea that styrene and divinyl benzene could be polymerized in the presence of water and an organic swelling agent. The present counts define something much narrower than Mindick's "general idea."

Conception must be something more than a general idea; rather conception must include all the essential features of the count. *Cislak* v. *Wagner*, 42 CCPA 701, 215 F.2d 275, 103 USPQ 39 (1954). Moreover, conception can only be established by showing "the formation in the mind of the inventor of a definite and permanent idea of the complete and operative invention as it is thereafter to be applied in practice. . . ." *Fredkin* v. *Irasek*, 55 CCPA 1302, 397 F.2d 342, 158 USPQ 280 (1968), *cert. denied*, 393 U.S. 980, 159 USPQ 799 (1968); *Mergenthaler* v. *Scudder*, 11 App. D.C. 264, 1897 C.D. 724 (D.C. Cir. 1897).

It is obvious that Mindick has not shown conception. According to the Mindick patent (col. 1, lines 11-13), increased "water holding capacities result from proper selection of the solvent proportion according to the invention." Based on our reading of Mindick's patent, proper proportions are 30-70% by weight of the monomer solution (col. 1, line 64 through col. 3, line 10). Mindick's "Research Suggestion" does not mention the proportions of the counts. Moreover, Mindick stated on cross-examination that (1) the use of proportions outside the scope of the counts, i.e., 5% toluene, would constitute "a lim-

[9] DVB is divinyl benzene.

ited amount of an organic swelling solvent" within the meaning of Mindick Ex. 8 and (2) "[t]he word 'limited,' in research, suggests that I am not sure what I intended by saying that" (Record for Mindick, pp. 53 & 59). Lastly, we note that Mindick's "Research Suggestion" does not mention a single specific solvent which Mindick believed might be a suitable "organic swelling agent." Compare *Meitzner* v. *Corte, supra.*

This brings us to the actual experimental work performed by Mindick and his associates. Mindick did polymerize styrene and divinylbenzene in the presence of a solvent, but in the absence of water (Record for Mindick, p. 10). There is no evidence in the record that Mindick performed suspension polymerizations, i.e., polymerizations in which the monomers are copolymerized in the presence of a solvent and water as called for by the counts. The suspension polymerization experiments were carried out by Wen and Svarz.

The following table, with a footnote deleted, appears on page 31 of Mindick's brief and will be helpful in understanding the case. The data contained in the table is fairly supported by the record, except we note zinc chloride, not aluminum chloride, was used during chloromethylation of Resin Nos. JJS-8, JJS-9, and JJS-25.

MINDICK UNITED STATES PATENT 3,549,562
TABLE

ARRANGED IN CHRONOLOGICAL ORDER

Resin No.	Copolymerization				Chloro-Methylation	Analyses $Me_3\overset{\oplus}{N}$ Resin			
	Date	Solvent	%Solvent	%DVB		WHC	%Swell	%Shrink	Compr.
RW-585	9/6/55	Toluene	40%	16%	$ZnCl_2$, RT	46.6	27.4	5.5	32.0
RW-587	9/21/55	Chlorobenzene	40%	16%	$ZnCl_2$, RT	45.0	31.0	5.0	36.0
RW-590	10/5/55	Chlorobenzene	40%	12%	$ZnCl_2$, RT	47.4	32.9	3.6	36.5
RW-596	10/19/55	Benzene	40%	16%	$ZnCl_2$, RT	38.8	30.1	2.1	32.2
RW-597	10/25/55	Toluene	55%	20%	$ZnCl_2$, RT	53.8	39.4	2.9	42.5
RW-598	10/25/55	$EtCl_2$	40%	16%	$ZnCl_2$, RT	42.3	34.0	1.4	35.4
JJS-8	11/28/55	Xylene	40%	20%	$AlCl_3$, RT	40.1	26.0	2.1	28.1
JJS-9	11/28/55	Xylene	50%	20%	$AlCl_3$, RT	44.9	23.1	2.8	25.9
JJS-25	1/12/56	Toluene	55%	20%	$AlCl_3$, RT	52.0	23.9	3.6	27.5
JJS-26	1/12/56	Toluene	55%	20%	$AlCl_3/ZnCl_2$,RT	52.6	21.0	3.6	24.6
JJS-38	1/30/56	Toluene	55%	20%	$AlCl_3$ Reflux	53.7	18.3	3.7	22.0
JJS-39	1/30/56	Toluene	55%	20%	$SnCl_4$,Reflux	54.3	17.6	5.1	22.7
JJS-43	2/8/56	Toluene	55%	20%	$AlCl_3$,Reflux	53.5	13.6	2.9	16.5
JJS-52	2/20/56	Toluene	60%	20%	$AlCl_3$,Reflux	56.0	17.9	2.7	20.6
JJS-53	2/22/56	Toluene	65%	20%	$AlCl_3$,Reflux	62.2	16.1	3.1	19.2
JJS-58	2/22/56	Toluene	50%	20%	$AlCl_3$,Reflux	49.4	7 1	1.0	8.1

During 1955, Wen prepared various ion exchange resins designated as RW-587 through RW-598 in the table.[10] While Wen testified that his experimental work "originated" from Mindick's "Research Suggestion" (Record for Mindick, pp. 146 & 171), Wen also stated that it was his general practice to design his own experiments, including selection of the "conditions of reaction," "the materials," and "the proportions of the materials" (Record for Mindick, pp. 230-231). Wen never stated that Mindick told him to use 40% or 55% solvent as shown in the RW resins in the table.

At this point, we wish to note that the ion exchange resins prepared by Wen and method used by Wen to prepare those ion exchange resins, while falling within the scope of counts 1 through 4, do not fall within the scope of counts 5 through 10. Counts 5 through 10 call for "a volume expansion on conversion into hydroxide form of less than 30 percent" and Wen's resin have a volume expansion (listed as % Swell in the table) of greater than 30.0% in each instance.

After Wen left Mindick's assignee, Svarz prepared various ion exchange resins designated as JJS-8 through JJS-58 in the table. The various ion exchange resins prepared by Svarz and the method used by Svarz to prepare those ion exchange resins fall within the scope of all counts. However, there is nothing in the testimony of Svarz which indicates that Svarz attributes the specific proportions of solvent used in making Resin Nos. JJS-8 through JJS-58 to any specific suggestion of Mindick. Likewise, Mindick did not testify that he made any such specific suggestion to Svarz.

Based on the record before us, we are unable to conclude that Mindick, as a sole inventor, conceived and

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[10] Resin No. RW-585 was not made by suspension polymerization and is therefore outside the scope of the counts.

actually reduced to practice the invention defined by the counts prior to the time Mindick and Svarz filed application, Serial No. 691,541, on October 22, 1957. Accordingly, the party Mindick and Svarz are limited to their effective filing date.

4. *Meitzner Priority Proofs*

Meitzner alleges a conception in January, 1957 (brief, p. 24). Meitzner further alleges that in March, 1957, one Sigafoos, "operating under . . . [a] conception of . . . Meitzner . . . and under the direction of . . . [named co-inventor] Oline copolymerized in water suspension a mixture containing [80%] styrene and 20% DVB dissolved in 35% t-amyl alcohol and produced raw beads . . ." (brief, p. 25). Meitzner still further alleges that, based on an EDC volume swelling ratio" test, the raw beads were considered to have "a more porous structure" (brief, p. 26). Meitzner alleges that the raw beads were sulfonated to make ion exchange resins which had "a high degree of porosity . . ." (brief, p. 26). Lastly, Meitzner alleges that testing which took place by August 1, 1957, "bore out the unique qualities" of the ion exchange resin prepared by Sigafoos (brief, p. 29).

None of the above-mentioned allegations of Meitzner were denied or controverted in Mindick's brief. We have considered the various portions of the record referred to by Meitzner in his brief in support of his allegations and we find the record supports the allegations by a preponderance of evidence. We will further observe that named co-inventor Oline told Sigafoos what preparations to make (Record for Meitzner, p. 882) and that Mindick has not questioned whether Meitzner and Oline are joint inventors. Accordingly, we hold that Meitzner conceived and actually reduced the invention defined by counts 1 through 4 prior to Mindick's effective filing date, *viz.*, October 22, 1957.

5. *Mindick's Arguments with Respect to Meitzner's Priority Proofs*

Mindick's arguments with respect to Meitzner's proofs appear on pages 42 and 43 of Mindick's brief.

Mindick notes that Meitzner's proofs involve the use of a non-swelling solvent, i.e., tertiary amyl alcohol. We will merely note that the solvent called for by the counts is defined in such a manner as to cover the use of tertiary amyl alcohol.

Mindick notes that Meitzner already lost an interference to Corte in which he attempted to prove priority using work performed with tertiary amyl alcohol. We repeat, at this point, the comments made in the next to the last paragraph under the heading *"Mindick Motion for Judgment on the Record," supra.*

Mindick claims that the work done by Sigafoos was subsequent to Mindick's actual reduction to practice. In view of our disposition of Mindick's priority proofs, it is obvious we disagree.

Mindick, relying on Meitzner Exhibit 147, argues that even as late as November 26, 1957, Meitzner believed the invention "was still in a preliminary stage . . . ." We believe Mindick has misread Exhibit 147. When the exhibit is considered as a whole, in light of the record, we believe any statements therein which might be considered "doubts" on Meitzner's part relate to attempts to commercialize the invention as opposed to "doubts" as to a conviction of success or an actual reduction to practice. It should be manifest that an invention need not have been developed to the stage of commercialization to support a finding of an actual reduction to practice.

6. *Counts 5 through 10*

Meitzner does not contend that any experimental work falling within the scope of counts 5 through 10 was per-

formed by Meitzner prior to Mindick's effective filing date. Rather, Meitzner argues, with respect to counts 5, 6, and 9, that the raw beads made by Sigafoos inherently possessed the characteristics called for by these counts. There is no evidence in the record that Meitzner or his associates at Rohm and Haas Company appreciated this fact prior to Mindick's effective filing date. Meitzner's contention is apparently made on the basis of tests performed after Mindick's filing date. Assuming that any such tests are accurate, we believe Meitzner is attempting to prove conception and actual reduction to practice of the invention defined by counts 5, 6, and 9 *nunc pro tunc*. Compare *Langer* v. *Kaufman*, 59 CCPA 1261, 564 F.2d 915, 175 USPQ 172 (1972).

Turning to counts 7, 8, and 10, Meitzner contends the subject matter thereof is an obvious extension of the subject matter of counts 1 through 4 (brief, p. 31) and "the chloromethylation and amination techniques represent excess baggage and contribute nothing novel or patentable" over counts 1 through 4 (brief, p. 32).

We cannot agree with Meitzner that he would be entitled to an award of priority with respect to counts 5 through 10 merely on the basis of his having conceived and actually reduced to practice, prior to Mindick, of the subject matter of counts 1 through 4. Every limitation in a count is material and must be proved to show a reduction to practice. *Fredkin* v. *Irasek*, *supra*. Meitzner has not shown that he chloromethylated and aminated required by counts 7, 8, and 10. Moreover Mindick's proofs make it clear that the process defined by counts 1 through 4 will not necessarily result in raw beads which upon chloromethylation and amination result in ion exchange resins having all the characteristics mentioned in counts 5 through 10. In this connection, note that the Wen ion exchange resins in the table, *supra*, do not pos-

sess the noted characteristics, whereas the Svarz ion exchange resins do possess those characteristics.

7. *Summary of the Priority Proofs*

For the sake of completeness, we indicate that we would award priority, based on the proofs alone, as follows: (1) counts 1 through 4 to Meitzner and (2) counts 5 through 10 to Mindick.

Decision

Priority of invention of the subject matter of all the counts, *viz.*, counts 1 through 10, is awarded to Morris Mindick and Jerry J. Svarz, the senior party.

BOARD OF PATENT INTERFERENCES

/s/ Walter A. Modance
WALTER A. MODANCE
Examiner of Interferences

/s/ Fred E. McKelvey
FRED E. MCKELVEY
Examiner of Interferences

/s/ Ian A. Calvert
IAN A. CALVERT
Examiner of Interferences

UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

Patent Appeal No. 76-577

Interference No. 97,787

ERICH F. MEITZNER AND JAMES A. OLINE,
Appellants,

v.

MORRIS MINDICK AND JERRY J. SVARZ,
Appellees.

DECIDED: FEBRUARY 24, 1977

MILLER, Judge.

The junior party, Meitzner and Oline (Meitzner),[1] appeals from the decision[2] of the Patent and Trademark Office (PTO) Board of Patent Interferences (board) awarding priority of the invention described in the ten counts in issue to the senior party, Mindick and Svarz (Mindick).[3] We affirm.

The Invention

The invention involves a process of making porous copolymer beads and of forming these beads into anion-

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[1] Involved on application serial No. 749,526, filed July 18, 1958, and entitled "Polymerization Processes and Products Therefrom."

[2] In interference No. 97,787.

[3] Involved on patent No. 3,549,562, entitled "Production of Ion Exchange Resin Particles," issued December 22, 1970, on application serial No. 463,923, filed June 14, 1965, a continuation of application serial No. 691, 541, filed October 22, 1957, the benefit of whose filing date was accorded Mindick for purposes of this interference.

exchange resins; also, the copolymer-bead and anion-exchange-resin products. Counts 1-6 are directed to a process of making porous copolymer beads, with counts 5 and 6 further limited to beads "suitable for preparation of ion-exchange resin beads"; counts 7 and 8 add the steps of forming the anion-exchange resins; count 9 is a product-by-process claim to the copolymer beads; and count 10 is a product-by-product claim to the anion-exchange resins. The process comprises copolymerizing a monovinyl aromatic monomer (*e.g.*, styrene) and polyvinyl aromatic monomer (*e.g.*, divinyl benzene) in an inert organic liquid that is a solvent for the monomers but a nonsolvent for the copolymer, while the monomer-organic liquid solution is dispersed in water, thereby forming porous beads of the copolymer. The porous beads are then chloromethylated and aminated to introduce anion-exchange groups therein. Counts 1, 5, and 7 are illustrative:

> 1. A process for producing copolymers of increased porosity which comprises:
>
> (A) dissolving from 50 to 88% by weight of a mononvinyl aromatic monomer and from 12 to 50% of a polyvinyl aromatic monomer in an inert organic liquid which is a solvent for the monomers but is a nonsolvent for the polymerized product of the monovinyl and polyvinyl monomers, said solvent being present in an amount of about 30 to 70% by weight based on the weight of solution;
>
> (B) incorporating said solution into an excess of water to form a dispersion of droplets; and
>
> (C) copolymerizing said monovinyl and said polyvinyl monomers while suspended in said aqueous medium and in the presence of said inert organic liquid.

5. A process for producing solid vinylaromatic copolymer beads suitable for preparation of ion-exchange resin beads characterized by increased porosity and reduced swelling and shrinkage in use which comprises:

(A) dissolving a monovinyl aromatic monomer and a polyvinyl aromatic monomer in an inert organic liquid which is a solvent for the monomers but is a nonsolvent for the polymerized product of the monovinyl and polyvinyl monomers, said solvent being present in an amount of about 30 to 70% by weight based on the weight of solution;

(B) suspending the monomer solution as dispersed droplets in an aqueous dispersion medium; and

(C) copolymerizing said monomers in aqueous dispersion to form solid copolymer beads which upon chloromethylation to give an average of from 0.75 to 1.5 chloromethyl groups per aromatic nucleus and subsequent amination with trimethylamine yield trimethyl quaternary ammonium anion-exchange resins characterized in chloride form by:

(1) a water holding capacity of from 40 to 65 weight percent; and

(2) a volume expansion on conversion into hydroxide form of less than 30 percent.

7. A process for producing anion-exchange resins which comprises: chloromethylating a vinyl aromatic copolymer produced by the process of Count 5 to give an average of from 0.75 to 1.5 chloromethyl groups per aromatic nucleus, and thereafter aminating the chloromethylated copolymer to give an anion-exchange resin.

Background

This is the third interference involving Meitzner and Mindick and the same applications or parent applications thereof. The first (No. 92,815) involved Meitzner, Mindick, and Corte (Corte and Meyer). When declared, the senior party was determined to be Mindick. During the motions period, both Meitzner and Corte moved to dissolve, under what was then 37 CFR 1.232 (subsequently 37 CFR 1.231), due to unpatentability of the count over the prior art. Contingent on denial of their motion to dissolve, Meitzner also proposed a substitute count; and, contingent on denial of their motion to dissolve, Corte also moved for the benefit of the filing date of a German application under 35 USC 119 and to shift the burden of proof (making Corte the senior party). Mindick moved to substitute a count, which motion was opposed by Meitzner on the ground that the substitute count was unpatentable over the prior art. The Meitzner and Corte motions to dissolve were granted, as was Corte's motion for the benefit of the filing date of the German application and to shift the burden of proof. The motion of Mindick to substitute was denied because the substitute count was considered unpatentable over the prior art. After a petition (filed by Mindick) for reconsideration of (1) the decision to accord Corte the benefit of their foreign filing date and to shift the burden of proof, and (2) the decision to dissolve due to the unpatentability of the count (reconsideration of the decision to dissolve was opposed by Meitzner), the decisions were adhered to, and No. 92,815 was dissolved.

Mindick then filed a continuation application.

A second interference (No. 96,314), also involving Meitzner, Mindick, and Corte, was next declared on a different (phantom) count. As in the first interference, the senior party was determined to be Mindick. During the motions period, both Meitzner and Corte filed motions

to dissolve due to unpatentability of the count over the prior art. Contingent on denial of their motion, Meitzner also moved to substitute counts; and, contingent on denial of their motion, Corte also moved to be accorded their foreign priority date and to shift the burden of proof (making Corte the senior party). In contrast to the first interference, the motions to dissolve were denied. The motion of Meitzner to substitute counts was also denied. The motion of Corte for their foreign priority date and to shift the burden of proof was granted. Meitzner then petitioned the Commissioner, urging that the count was unpatentable and that their proposed counts should be substituted. The Commissioner, acting through the First Assistant Commissioner and without reaching the merits of the petition, issued an order to show cause why No. 96,314 should not be dissolved. Both Meitzner and Mindick maintained that the interference should not be dissolved, with Meitzner arguing that the interference should continue on their proposed substitute counts. Nevertheless, the Commissioner dissolved the proceeding for failure "to litigate matters which could and should have been raised in prior interference No. 92,815 involving the same parties."

The Mindick application then reverted to ex parte prosecution, where the examiner rejected some of the claims on junior party estoppel arising from No. 96,314. Mindick petitioned the Commisssioner for review of the estoppel rejection. The Commissioner, acting through the Group Director, granted the petition, holding that "the examiner erred in placing [Mindick] in the status of junior party in Interference No. 96,314 and any rejection based on such junior party status is improper," because the decision granting the motion to Corte to shift in No. 96,314 was vacated by the Commissioner's dissolution of that interference. This left Mindick as the senior party in No. 96,314. The Mindick application was then passed to issue.

After the patent issued, Meitzner presented four claims for purposes of an interference with the Mindick patent, and the present interference was declared. During the motions period, Meitzner moved to amend by adding present counts 5-10, and Mindick moved to dissolve the interference on junior party estoppel for failure of Meitzner in the first interference to contest priority on all subject matter common to the Mindick and Meitzner applications. The motion to add counts was granted, and the motion to dissolve was denied because the Primary Examiner said he could not find a "clear basis" for applying estoppel.

Board Opinion

The board considered, among other issues,[4] whether there was junior party estoppel of Meitzner from contesting priority vis-à-vis Mindick with respect to counts 1-10, essentially the issue raised by Mindick's motion to dissolve which had been denied by the Primary Examiner. Based on findings of fact substantially as related above, it held Meitzner estopped from contesting "priority of the subject matter here involved," since they "failed, in Inference No. 92,815, to seek to contest priority *vis-à-vis* Mindick (with or without Corte) with respect to the present counts." It said that dissolution of that interference settled not only the rights of Mindick and Meitzner with respect to the count there involved, but also their rights with respect to *any* count that might have

[4] The board also considered (1) Mindick's motion for judgment on the record, and (2) Mindick's motion to dissolve based on 35 USC 135(b). After making its determination on the estoppel issue, the board considered each party's priority proofs. In considering Mindick's priority proofs, the board rejected the Meitzner priority proofs, the board rejected the Meitzner argument that Mindick, having failed to move for the benefit of their parent application with respect to counts 5-10 (when Meitzner moved to add these counts during the motions period), could not claim the benefit of their parent application and should have been made junior party. The board said that the time for Meitzner to raise this point was after the testimony period was set, with Meitzner designated to proceed first, as junior party.

been the basis for a priority contest between them. The board added:

> Meitzner made no effort to move positively to contest priority of any proposed count in Interference No. 92,815, because his contingent motion to substitute was predicated on the Primary Examiner denying Meitzner's motion to dissolve. When the Primary Examiner granted Meitzner's motion to dissolve, Meitzner received all the relief in Interference No. 92,815 which he requested.

Although recognizing that Mindick had failed to raise the junior party estoppel issue in the second proceeding (No. 96,314), the board noted that the proceeding had been dissolved "based squarely on an estoppel theory." Finally, the board said:

> One reading the various decisions of the First Assistant Commissioner might well reach a conclusion that the estoppel was to run against both Meitzner and Mindick. However, such a conclusion would be plainly at odds with the provisions of 37 C.F.R. 1.257 (b), which provide, in effect, that estoppel does not apply to a party enjoying the status of a senior party in an interference which is dissolved as a result of a motion under 37 C.F.R. 1,231. We note that consistent with the provisions of 37 C.F.R. 1,257(b), the Director held the Primary Examiner's action rejecting Mindick's claims 1 through 4 on the ground of junior party estoppel to have been improper.
>
> Accordingly, the board awarded priority to Mindick on counts 1-10.

OPINION

Estoppel

We agree with the board that there is estoppel against Meitzner from claiming the subject matter of the present

counts. Meitzner failed to contest priority with respect to such subject matter in the first interference.[5]

This court has held that a party to an interference has a duty to present *all* claims involving common subject matter with *any* of the other parties in the proceeding, and that failure to timely present these claims estops him from presenting them at a later time. *In re Shimer*, 21 CCPA 979, 69 F.2d 556, 21 USPQ 161 (1934). In that case the court said:

> [A]ppellant argues that there was no common subject matter between his application and that of MacClatchie in said interference, but that there was such common subject matter between his application and that of Paterson et al., another party thereto; that the addition of said counts would have resulted only in a redeclaration of intereference between appellant and the party Paterson et al., which would have resulted in no injury to Paterson et al. . . . .
>
> . . . . [I]f the matter was one which might have been determined in the first interference, the party having a right to have them [sic, it] so determined, who fails to do so, cannot afterwards require their [sic, its] consideration. The rule prevails, irrespective of the number of parties in the original interference. In determining whether the same could have been so determined, the interference in fact depends

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[5] Also, we do not agree with Meitzner (see note 4, *supra*) that the board erred "in excusing Mindick et al's failure [in this interference] to move for the benefit of his [sic, their] parent application regarding counts 5 through 10" and "in summarily assuming that counts 5 through 10 are supported by the 1957 Mindick et al parent application." Under 37 CFR 1.224 Mindick could rely on their parent application since it was specified in the notice of interference. *Breen* v. *Cobb*, 487 F.2d 558, 179 USPQ 733 (CCPA 1973). If Meitzner questioned whether such reliance extended to added counts 5-10, it was for them to raise the isue after the testimony period was set.

> chiefly upon the subject matter disclosed, and not merely upon the language of the respective claims.
> . . .
> . . . .
> It may be stated that this rule works no hardship to him who is diligent in pursuit of his rights. When an interference is declared, the files of his contestants are open to him. He has full cognizance of their disclosures and claims. So advised, it becomes his duty to put forward every claim he has. Rule 109 [6] affords him this opportunity. If the rule be not enforced or enforceable, then delays and litigation are greatly increased. It is quite obvious that the doctrine of estoppel . . . results in the better conduct of the business of the Patent Office and in the public good. [*Id.* at 981-83, 69 F.2d at 557-58, 21 USPQ at 163.]

Accord, Avery v. *Chase*, 26 CCPA 823, 101 F.2d 205, 40 USPQ 343, *cert. denied*, 307 U.S. 638, 41 USPQ 799 (1939). *Contra American Cyanamid Co.* v. *Coe*, 106 F.2d 851, 42 USPQ 302 (CA D.C. 1939); *International Cellucotton Products Co.* v. *Coe*, 85 F.2d 869, 30 USPQ 366 (CA D.C. 1936). This doctrine of estoppel does not apply, however, to a party enjoying the status of a senior party in an interference that is dissolved as a result of a motion under 37 CFR 1.231. See 37 CFR 1.257(b).

The record clearly shows that Meitzner could have added the subject matter of the present counts in the first interference. The Meitzner application specification in the present interference is the same as in the first interference; and the Mindick patent specification is substantially the same as the application specification in the first interference. As admitted by Meitzner in their reply brief, only subject matter on two lines in the parent application was omitted in the patent specification involved in this proceeding.

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[6] The pertinent portions of then-Rule 109 are in substance incorporated in 37 CFR 1.231.

It is argued by Meitzner that the board improperly found them estopped on counts 1-4, because the Mindick parent application does not clearly disclose "copolymers of increased porosity" of any type, as recited in counts 1-4, so that these counts could not have been made in any prior interference. They state that the Mindick parent application only discloses *ion-exchange resins* of increased porosity. However, we note that the Mindick parent application expressly discloses that "porosity is achieved . . . by polymerizing the monomers in the presence of certain proportions of a water-immiscible organic liquid solvent for the monomers," which is a clear disclosure that the *copolymer* has porosity. Also, this argument by Meitzner is contradicted by their statement in the first interference, namely:

> While the utility for the inventions in each of the applications in interference is in ion exchange resins, the improvements disclosed have to do with the preparation of a divinylbenzene-styrene copolymer which by steps well known in the art may be converted to an ion exchange resin. . . . It is apparent, therefore, that any common invention that exists among the applications in interference resides in the preparation of the base polymer . . . .

The statement recognizes that the "improvements" (*e.g.*, increased porosity) are in the copolymer.

It is further argued by Meitzner that the process disclosed in the Mindick parent application does not form copolymers having a "true porosity" (*i.e.*, macroporous structure), so that the application does not clearly disclose "copolymers of increased porosity." However, counts 1-4 do not require such a "true porosity," and it has not been shown that *only* copolymers having a macroporous structure have "porosity." Indeed, as acknowledged by Meitzner, the gel-type structures of the prior art have a "gel porosity." Even if counts 1.4 were limited to a

process of forming copolymers having such a "true porosity," the argument that the Mindick parent application does not disclose "true porosity" is unsupported by evidence. Argument of counsel cannot take the place of evidence lacking in the record. *In re Lindner*, 59 CCPA 920, 457 F.2d 506, 173 USPQ 356 (1972); *In re Schulze*, 52 CCPA 1422, 346 F.2d 600, 145 USPQ 716 (1965).

We disagree with the contention of Meitzner that Mindick waived their right to raise junior party estoppel in this interference by not raising it in the *second* interference. It is stated by Meitzner that "[c]onsiderable delay and vexatious litigation might have been avoided had Mindick et al. acted in a timely fashion and brought the motion to dissolve based on alleged estoppel in the second interference." However, we note that the second interference was dissolved, following the Commissioner's order to show cause, on the basis of estoppel for failure "to litigate matters which could and should have been raised in [the first interference]." Thus, Meitzner suffered no "considerable delay and vexatious litigation." Although Mindick did not raise the issue, the reason for applying the waiver doctrine, as urged by Meitzner, is nonexistent. It is further stated by Meitzner that, by failing to move for dissolution of the second interference, Mindick "denied to Meitzner et al. their right to proceed . . . with a motion to amend and/or to adversary argument before the Primary Examiner . . . ." However, the substance of the asserted "right" is speculative since Meitzner had moved before the Primary Examiner to substitute counts (which motion was denied).

Reliance by Meitzner on *Vickery* v. *Barnhart*, 28 CCPA 979, 118 F.2d 578, 49 USPQ 106 (1941), for the proposition that Mindick waived their right to rely on junior party estoppel is misplaced. In *Vickery*, this court held that the appellant was not allowed to raise the issue of

disclaimer of invention *in the same proceeding*, since he had failed to timely move to dissolve the interference on that basis; hence the estoppel was based on a failure to follow Patent Office rules. The estoppel issue was properly raised *in the present proceeding* by a motion to dissolve.

It is contended by Meitzner that the board's holding that the Primary Examiner erred in the first interference in according Corte senior party status suggests that the present interference is an extension or continuation of the first interference. We do not agree. There was over a seven-year hiatus between termination of the first interference and commencement of this proceeding; moreover, the parties in the first interference were different from those in the present one, Corte being omitted here.

It is urged by Meitzner that "it is inequitable to find Meitzner et al. estopped after finding Mindick et al., another junior party, not to be estopped," and that "[i]t is immaterial that Meitzner et al. is junior to Mindick et al." We do not agree. First, Mindick and Svarz were not "another junior party" in the first proceeding, but the senior party, since, as noted by the board, "the decision of the Primary Examiner granting Corte's motion [to shift the burden of proof] was clearly erroneous inasmuch as at the same time the Primary Examiner dissolved the interference." Second, even if Corte were the senior party in the first proceeding, this would be of no avail to Meitzner. Only estoppel against a party *and in favor of the opponent* is ancillary to the question of priority. *Bechtold* v. *Lanser*, 23 CCPA 1051, 82 F.2d 415, 29 USPQ 130 (1936). The estoppel against Mindick suggested by Meitzner would not be "in favor of" Meitzner, but rather "in favor of" Corte.

In view of the foregoing, we need not reach the other issues raised before the board.

It is argued by Meitzner that "misrepresentations" by Mindick in ex parte prosecution of their patent applica-

tion and in their actions before the Board [7] render them a party with "unclean hands," and thus they should not be allowed to rely on the equitable doctrine of estoppel. However, this issue was not raised before the board and, therefor, is not timely raised now. See *Vogel* v. *Jones*, 486 F.2d 1068, 179 USPQ 425 (CCPA 1973); *Triggiana* v. *Gens*, 482 F.2d 1381, 179 USPQ 236 (CCPA 1973).

Fraud

It is alleged by Meitzner that the Mindick patent "contains false data the effects of which were to misrepresent and/or conceal the material facts and to mislead the PTO." Specifically, it is alleged that misrepresentations in the disclosure of test # 585 (which involved a bulk polymerization process) as a dispersion polymerization process and in the disclosure of certain chloromethylation catalysts (which were in fact zinc chloride) as aluminum chloride constitute "fraud and deception practices by Mindick et al. upon the Patent and Trademark Office."

It is clear, however, that the fraud issue was not raised before the board, notwithstanding that the facts upon which the allegation of fraud is based were developed during proceedings before the board. Moreover, the reasons of appeal set forth by Meitzner do not allege fraud as a basis of error in the board's decision. Accordingly, the issue is not properly before us. *Goodrich* v. *Harmsen*, 58 CCPA 1144, 442 F.2d 377, 169 USPQ 553 (1971). See *Vogel* v. *Jones*, *supra*; *Triggiana* v. *Gens*, *supra*.

Attorney's Fees and Costs

Both parties have argued that they should be awarded attorney's fees and costs. Basis for the award advanced

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[7] It is also argued by Meitzner that "[n]o corrective notations [to a table submitted to the board] have been made by Mindick et al. to this Court either." However, since, as stated by Meitzner, the "misrepresentations" are revealed in Svarz's testimony and this is of record, such "corrective notations" are not needed.

by Mindick is "[t]he unconscionable action of Meitzner in subjecting the assignee of the Mindick and Svarz patent to an interference where the work initially relied upon by Meitzner was known to have been abandoned." Basis for the award advanced by Meitzner is the fraud on the PTO allegedly perpetrated by Mindick in obtaining his patent.

Generally, each party should bear his own costs of litigation, including attorney's fees. *Alyeska Pipeline Service Co.* v. *Wilderness Society*, 421 U.S. 240, 257 (1975). However, there are exceptions. Thus, where a statute or an enforceable contract so provide, attorney's fees are recoverable. *Fleischmann Distilling Corp.* v. *Maier Brewing Co.*, 386 U.S. 714, 153 USPQ 432 (1967). Attorney's fees have been awarded to a successful party "when his opponent has acted in bad faith, vexatiously, wantonly, or for oppressive reasons, or where a successful litigant has conferred a substantial benefit on a class of persons and the court's shifting of fees operates to spread the cost proportionately among the members of the benefitted class." (Footnotes omitted.) *F. D. Rich Co.* v. *Industrial Lumber Co.*, 417 U.S. 116, 129-30 (1974). We are not persuaded that the record before us justifies an exception to the general rule.

It is urged by Mindick that we consider our position in *Reddy* v. *Dann*, 529 F.2d 1347, 188 USPQ 644 (CCPA 1976), and hold that "this Court is empowered to award attorney's fees under [35 USC 285 [8]] in exceptional interference cases." However, we adhere to the statement in that case that "[s]ection 285 . . . is clearly inapplicable to this court." *Id.* at 1349, 188 USPQ at 645.

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[8] § 285. *Attorney fees.*

The court in exceptional cases may award reasonable attorney fees to the prevailing party.

It is pointed out by Mindick that "28 USC 1912 [9] specifically authorizes a court of appeals to make [an award of attorney's fees] as part of the 'just damages' which may be awarded in the Court's discretion, and 28 USC 1927 [10] authorizes any court of the United States to assess the excess costs occasioned by unreasonable and vexatious proceedings against the attorney responsible for them." However, 28 USC 1912 only applies to "the Supreme Court or a court of appeals," and this court is not a "court of appeals" for purposes of *that* statute.[11] Although 28 USC 1927 is applicable to proceedings before this court,[12] we are not persuaded that such proceedings instituted by Meitzner have increased the costs unreasonably and vexatiously, as required by the statute.[13] We

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[9] § 1912. *Damages and costs on ffirmances.*

Where a judgment is affirmed by the Supreme Court or a court of appeals, the court in its discretion may adjudge to the prevailing party just damages for his delay, and single or double costs.

[10] § 1927. *Counsel's liability for excessive costs.*

Any attorney or other person admitted to conduct cases in any court of the United States or any Territory thereof who so multiplies the proceedings in any case as to increase costs unreasonably and vexatiously may be required by the court to satisfy personally such excess costs.

[11] Compare 28 USC 1913 with 28 USC 1926.

[12] Indirectly, attorney's fees could be included in determining "excessive costs" for purposes of this statute.

[13] It is argued by Mindick that the deposition of Dr. Harold Weaver (a chemist "in Technical Sales and Technical Sales Development in ion exchange resins" of the assignee of Meitzner at the time the present invention was made) shows that Meitzner had "abandoned" the work relating to swelling solvents, and, thus, that they are not entitled to a patent directed either to the use of swelling solvents or to the generic solvent counts of the present invention; and that subjecting Mindick to the present proceeding, in view of the "abandonment," warrants the award of attorney's fees. However, we note that Weaver's deposition merely shows that "it was very definitely the feeling of the inventors" that use of a non-swelling solvent "gave us something that distinguished it to a much

note, in this connection, the background of this case set forth above, which shows that in the earlier proceedings there was considerable confusion within the PTO itself.

Taxation of Printing Costs

Meitzner has moved to assess printing costs against Mindick for the portions of the transcript requested by Mindick. These can be divided into two groups: (1) those portions relating to the estoppel issue, and (2) those portions relating to the Mindick request for an award of attorney's fees and costs.

In determining the taxation of printing costs for portions of the transcript requested by appellees, appellants are only required to pay for so much of the transcript as is necessary for the court to decide the issues *they* raised on appeal; the costs of material needed for the court to make a decision on the issues raised by appellees and of unnecessary materials should be taxed against appellees. *Myers* v. *Feigelman*, 59 CCPA 834, 455 F.2d 596, 172 USPQ 580 (1972). Those portions of the transcript relating to the estoppel issue, which was raised by Meitzner in their Notice and Reasons of Appeal, are considered necessary for the court's decision on this issue. Accordingly, the cost thereof is to be paid by Meitzner. The portions of the transcript requested by Mindick relating to their request for an award of attorney's fees and costs [14] are to be paid by Mindick.

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greater extent over the prior art than did anything prepared by the use of toluene or other swelling solvents," and that this was "the basis for leaving toluene out of the [Meitzner] application." We agree with Meitzner that the application is broad enough to cover swelling solvents and that "exclusion of an express disclosure of an inferior mode" does not constitute abandonment under the circumstances of this case.

[14] Items 9 and 13-17 of the listing filed with the court on March 19, 1976.

The decision of the board awarding priority to Mindick on counts 1-10 is *affirmed.*

AFFIRMED

UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

Thursday, April 28, 1977

Before: Markey, Chief Judge Rich, Baldwin, Lane and Miller, Associate Judges; Judge Kashiwa, United States Court of Claims and Judge Richardson, United States Customs Court.

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PETITIONS FOR REHEARING

No. 76-577, ERICH F. MEITZNER and JAMES A. OLINE v. MORRIS MINDICK and JERRY J. SVARZ. The petition for rehearing is denied.

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April 28, 1977